

REMARKS

I. Objection to the Oath

Claims 6-23 in application serial number 09/375,471 (hereinafter, “‘471”) were objected to as being directed to subject matter not originally claimed or embraced in the statement of the invention. No currently pending claims correspond exactly to claims 6-23 of ‘471. However, to the extent the Office intends to make a similar objection in the present case, the Applicants proffer to submit a supplemental oath/declaration for this continuation application which, when submitted, will render the objections moot.

II. Objection to the Specification

The Official Action states that the specification of ‘471 is objected to because it fails to describe “a plurality of power outputs and a plurality of intelligent power sections disposed in a power control housing.” To the extent the Office intends to make a similar rejection in the present case, the Applicants note the following.

The Applicants respectfully submit that the claimed “plurality of power outputs and a plurality of intelligent power sections disposed in a power control housing” is supported in the originally filed specification at page 13, lines 21-24 which states that that intelligent power modules 30, 32, 34, 36 [a plurality of intelligent power sections] may be located internal to UPS 26 [a power control housing]. Additionally, the originally filed specification, at page 8, lines 15-17, states that **each** Intelligent Power Module is able to **independently control** power on/off status of **several** network appliances [each intelligent power section has a plurality of power outputs]. The substitute drawing of Fig. 1 previously submitted was amended to include a dotted-line box which encompasses intelligent power modules 30, 32, 34, 36 and UPS 26, thereby

showing the plurality of power outputs and a plurality of intelligent power sections disposed in a power control housing.

The presently pending claims contain the limitations of “a plurality of power outlets mounted in the powers supply housing,” and “a plurality of intelligent power modules mounted in the power supply housing....” For the reasons discussed above, the Applicants respectfully submit that this language is similarly supported in the specification as filed. Accordingly, the Applicants believe the specification is not objectionable.

III. Rejection of Claims 6-17 and 20-23 Under 35 U.S.C. §112, ¶1

Claims 6-17 and 20-23 in ‘471 were rejected as failing to meet the written description requirement. The Official Action states that “The specification fails to describe a plurality of power outputs and a plurality of intelligent power sections disposed in a power control housing.” *See* Official Action at 4. While none of the presently pending claims correspond exactly to claims 6-17 and 20-23, Applicants provide the following comments to the extent the Office may intend to similarly reject the presently pending claims. For example, presently pending claim 6 contains the limitations of “a power supply housing” and “a plurality of intelligent power modules mounted in the power supply housing....”

The Official Action asserts that the plural term “external plug-in assemblies” used at page 22, lines 3-5 of the specification, when considered with the separate boxes used to show the intelligent power modules/sections in Fig. 1, fulfills the written description requirement for intelligent power modules as separate packages external to the UPS but does not meet the written description requirement for intelligent power modules in the same housing as the UPS. Applicants respectfully traverse the rejections and hereby incorporate the arguments presented above in response to the objection to the drawings.

Applicants further submit that the external plug-in assemblies referred to on page 22 of the specification are limited in context to embodiments employing “off-the-shelf UPS systems” **“where it is too late to incorporate such functionality...internally as intrinsic components of an uninterruptible power supply (UPS)”** [emphasis added] (see page 21, line 31 - page 22, line 5). In the apparatus as disclosed in the originally filed specification, as shown in figure 1, as amended herein, and as presently claimed, a plurality of intelligent power sections may be located **internal** to UPS 26 (a power control housing), each Intelligent Power Module being able to independently control power on/off status of several network appliances (each intelligent power section having a plurality of power outputs). *See* page 13, lines 21-24 and page 8, lines 15-17. Accordingly, Applicants respectfully submit that there is ample support in the originally filed specification for embodiments of the present invention having intelligent power modules located in a power supply housing. The presently pending claims are believed to fully comply with the requirement of 35 U.S.C. §112, ¶1.

IV. Objection to the Claim 17

Claim 17 in '471 was objected to as not having proper antecedent basis for the term “parallel electrical loads” at line 3. The term “parallel electrical loads” does not appear in the presently pending claims.

V. Rejection of Claims 6, 12, and 20 Under 35 U.S.C. §102(a)

Claims 6, 12, and 20 in '471 were rejected under 35 U.S.C. § 102(a) as anticipated by the Masterswitch reference (hereinafter, “Masterswitch”). There are no presently pending claims which exactly correspond to claims 6, 12, and 20 of '471. However, to the extent the Office

intends to apply Masterswitch against the presently pending claims, the Applicants make the following comments.

Applicants respectfully submit that Masterswitch does not qualify as prior art under 35 U.S.C. § 102(a). The test for anticipation under section 102 is whether each and every element as set forth in the claim is found, either expressly or inherently described, in a single *prior art* reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131. The elements must also be arranged as required by the claim. *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

A. Masterswitch Does Not Anticipate Applicants' Claims Because the Office Has Not Met Its Burden of Establishing Masterswitch as Prior Art

It is well settled that the Office bears the burden of establishing the effective date of a reference. *See, e.g., In re Natale*, 11 U.S.P.Q.2d 1222, 1226 (Bd. Pat. App. & Inter. 1989) (stating "The burden of establishing that a document was publicly accessible rests upon the examiner as part of his burden of establishing a prima facie basis for denying patentability."); *see also Mannesmann Demag Corp. v. Engineered Metal Products*, 226 U.S.P.Q. 466, 470 (D. Del. 1985). Without citing any authority, the Official Action asserts that since Masterswitch was cited in an IDS, the burden is on the Applicants to establish its publication date; and that since the Applicants merely cited the year of publication, the Office is entitled to assume the first day of the cited year as the date of publication. The Applicants respectfully disagree.

The Official Action states that the IDS in which the cited reference was listed failed to meet all the requirements of 37 CFR 1.98 because only a year, and not an exact date, was provided for Masterswitch. While 37 CFR 1.98 states that the "date" of publication be provided,

at the time Masterswitch was submitted, the Applicants knew only the year of the copyright notice appended to Masterswitch (and not whether that year correctly relates to the date of publication or dissemination). The Applicants met the requirements of 37 CFR 1.98 by stating the year copyright was claimed on the document itself. The Applicants never conceded any date of publication for Masterswitch. The Applicants are unaware of any authority that justifies bootstrapping the year stated in a copyright notice into a specific publication date.

As Chisum explains, “Generally, the date of publication is that date when the work is first received by any member of the public.” 1 Chisum on Patents §3.04; *see also Carella v. Starlight Archery*, 804 F.2d 135 (Fed. Cir. 1986). The Office provided no evidence of when the Masterswitch web page was received by any member of the public. Since there is no evidence of when the document was likely received by any members of the public, an assumption or presumption of early receipt in the year is unsupported and contrary to law. Accordingly, the Applicants respectfully submit that, in accordance with the law as set forth in *Mannesmann*, the Office has failed to meet its burden to prove that the cited reference qualifies as a prior art publication under section 102.

Despite the Office bearing the burden of establishing the effective date of Masterswitch, the Applicants have nevertheless researched the actual publication date of Masterswitch in order to aid the Office. Masterswitch is a web page press release by American Power Conversion (APC) announcing a product designated by the nomenclature “E515”. Further search of the internet yielded the web site: <http://www.prnewswire.com/gh/cnoc/comp/046187.html>, which lists articles related to APC, including an article dated November 18, 1996, entitled *APC brings power to the World Wide Web with it's Masterswitch E515 network manageable power distribution unit*. This article, attached as Exhibit A, is directed to the Masterswitch E515 and states that “American Power Conversion **today** announced it’s Masterswitch™ E515 network

manageable power distribution unit (PDU).” (Emphasis added). Accordingly, it appears that Masterswitch would not have published any earlier than November 18, 1996, after the Applicants’ filing date.

The Applicants respectfully submit that, particularly in view of the evidence that the Masterswitch E515 was announced by APC on November 18, 1996, any assumption of earlier publication of Masterswitch is contrary to all evidence in the record. The Applicants therefore respectfully submit that Applicants’ priority date of July 23, 1996, clearly antedates APC’s announcement, and Masterswitch cannot anticipate the Applicants’ presently pending claims.

B. Masterswitch, Considered Alone, Does Not Contain an Enabling Disclosure of All Elements of the Applicants Presently Pending Claims

The Official Action asserts that Masterswitch contains an enabling disclosure of the subject matter of claims 6, 12, and 20 of ‘471. However, the Applicants respectfully disagree that Masterswitch is enabling as to those claims, or the presently pending claims, because 1) Masterswitch is a vacuous promotional brochure that contains a bare list of features and absolutely no teaching of how to implement the features; 2) Masterswitch does not contain any “working examples”; and 3) there is no evidence of when, if ever, the devices purportedly described in Masterswitch actually existed. Therefore, even if the Office could establish Masterswitch as prior art, it would still would not anticipate the Applicants’ presently pending claims.

A reference must enable someone to practice the invention in order to anticipate under §102. *Symbol Technologies, Inc. v. Opto Electronics*, 19 U.S.P.Q.2d 1241 (Fed. Cir. 1991). To establish that Masterswitch is not enabled, in ‘471 the Applicants submitted the Declaration of James P. Maskaly under 37 C.F.R. § 1.132, a copy of which is incorporated herein and attached hereto as Exhibit B.

i. Masterswitch Contains Only A Bare List of Features and No Details of How to Implement Them

Prior art references that are not enabling are not anticipating. The Federal Circuit's holding in *Reading and Bates Constr. Co. v. Baker Energy Res. Corp.*, 223 U.S.P.Q. 1168 (Fed Cir. 1984), is dispositive here. In *Reading*, a promotional brochure asserted the ability and results of a claimed process. The Federal Circuit noted that, although a 1-page promotional brochure may qualify as a prior art reference, such a brochure is a reference “*only for what is disclosed in it.*” (Emphasis added). The Court further noted that “the mere fact that the ...brochure, a one-page promotional brochure, boasts the ability and results of the [claimed] process of the ... patent is insufficient, as a matter of law, to constitute an enabling disclosure” *Id.* So too here: the mere fact that Masterswitch boasts the ability and results of the claimed apparatus of the instant application is an insufficient basis for an anticipation rejection under §102 because the brochure does not contain an enabling disclosure of the material it promotes.

As evidenced by the Maskaly declaration, Masterswitch does not teach how to make the mechanical, electrical, electronic or programming details of the apparatus. The Maskaly declaration establishes that undue experimentation, “at least two (2) man years of engineering and development effort”, would be required by a person of ordinary skill in the art to make and use the presently claimed apparatus based on the content of Masterswitch. See ¶9.

Regarding the Maskaly declaration, the Official Action states that the declaration is defective because it does not a) establish that an investment of at least two man years in developing a working device according to Masterswitch is undue, b) discuss the state of the prior art, and c) address the existence of a working example. The Official Action appears to indicate an understanding that all of the *Wands* factors must be considered and point to a lack of enablement for a prima facie case of non-enablement to be established. See *In re Wands*, 858

F.2d 731 (Fed. Cir. 1988). However, the Federal Circuit has stated that the *Wands* factors are illustrative, not mandatory, and that not all of the *Wands* factors need be considered in determining enablement. *See Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1213 (Fed. Cir. 1991). In any case, the Applicants respectfully submit that these alleged deficiencies do not exist.

ii. The Maskaly Declaration Takes Into Account the State of the Prior Art and Establishes the Degree of Experimentation as Atypical

Thoughtful consideration of the Maskaly declaration provides insight into the factors with which the Official Action appears concerned. Regarding elements a and b, the Maskaly declaration's statement that it would take at least two man years to develop the product of Masterswitch addresses both the state of the prior art and establishes that the amount of experimentation is atypical. The figure of at least two man years takes into account the level of knowledge in art prior to Applicants' invention because Maskaly states that the two man year development time is for an ordinary artisan-who would presumably be familiar with the prior art. Reasons why specific cited, but not applied, references mentioned in the Official Action are not enabling are discussed further in Section VI, *infra*.

Two man years is not necessarily atypical for the development of a new project from scratch. The key point is this: the development time is the same *whether or not* Masterswitch is considered prior art. Masterswitch contains nothing that would enable one skilled in the art to build a device described by Masterswitch any faster. Accordingly, the development time is necessarily atypical compared to a situation where an enabling reference was provided.

iii. Masterswitch Does Not Contain Any Working Examples

As to element c, Applicants wish to clarify what does and does not constitute a working example. The *Wands* factors are typically applied during patent prosecuting in determining whether an *applicant's* claims meet the enablement requirement of 35 U.S.C. §112. Care must be taken in using the *Wands* factors to discuss whether an alleged prior art reference is enabling. It is true that one of the factors mentioned by *Wands* is “the presence or absence of working examples.” *In re Wands*, 858 F.2d 731 (Fed. Cir. 1988). These “working examples” are examples *included in an applicant's patent specification* to illustrate the claimed invention. See *In re Formal*, 230 U.S.P.Q. 547 (Bd. Pat. App. & Inter. 1986) (stating that “the absence of a working example was not in itself stated to cause the specification to be insufficiently enabling.”); see also 3 Chisum on Patents 7.05[3] (stating that “Generally, an applicant need not include in her specification a specific working example in order to comply with the enablement requirement...,” and “Specific examples are often included in patent specifications because examples can be the best method of teaching how to make and use the invention.”)

It appears that the Official Action may be asserting that the “working examples” of Masterswitch are the devices supposedly described in the advertisements. If so, these devices are not the type of “working examples” apparently contemplated by *Wands*. Significantly, the details of these “working examples” do not appear anywhere in Masterswitch, as they would in a patent application, and therefore do not contribute any enabling disclosure to Masterswitch.

Even if the Masterswitch devices existed, and even if they performed as advertised, they could not be considered working examples because no information about them is presented in Masterswitch. The existence (or nonexistence) of devices not described in any way in Masterswitch does nothing to enable Masterswitch itself.

- iv. Physical Embodiments of Masterswitch May Not Be Used to Anticipate Applicants' Presently Pending Claims Since No Details of the Embodiments Have Been Provided Nor Has Their Date of Availability Been Established

Whether devices purportedly described by Masterswitch might themselves constitute prior art is a separate question from whether the Masterswitch brochure is an enabling prior art reference. However, there is no evidence whatsoever as to when, if ever, a working device of the type described in the Masterswitch reference existed at all, much less when such a device became available to the public. Many companies prepare advertisements in advance of a product release. In some cases, a product that performs as described may be developed. In other cases, the advertisement itself may end up being the product. Numerous industries are subject to this “vaporware.” It is likely that the Masterswitch reference was a response to Applicants’ products and represented their felt need to develop a competing product. However, an advertisement does not mean that a functioning product existed.

The Official Action appears to be particularly focused on Masterswitch’s statements that the advertised devices are “UL Listed” and “FCC Verified.” However, these are likely to have been forward looking statements made by marketing personnel. These statements may have had no relation to products that actually existed. It may be very hard to sell products that are not UL listed or FCC verified. Accordingly, the marketing personnel may have placed these statements in the draft advertisement because they knew these certifications would eventually have to be obtained.

For the reasons discussed above, the fact that an advertisement exists often will be of little consequence, as in the present case, because the advertisement neither enables the thing advertised, provides a working example, nor proves the existence of a working embodiment of the thing advertised. Accordingly, Masterswitch does not provide an enabling disclosure,

provide working examples, or prove that there were existing devices that could qualify as prior art against the Applicants' claims.

Furthermore, the Applicants respectfully request the Office to consider that the test for enablement is the same for prior art as it is for patenting. The Applicants strongly doubt that the Office would be willing to grant a patent based on the scant disclosure of the Masterswitch advertisement or desire to set such a precedent.

VI. Rejection of Claims 6, 9-10, 12, 17, and 20-22 Under 35 U.S.C. §103(a)

Claims 6, 9-10, 12, 17, and 20-22 of '471 were rejected under 35 U.S.C. § 103(a) as obvious over WO93/10615 (Ewing I) and U.S. Patent No. 5,506,573 (Ewing II) in view of Solutions '94 (APC). There are no presently pending claims that correspond exactly to claims 6, 9-10, 12, 17, and 20-22 of that application. However, to the extent the Office intends to apply the same, or a similar, combination of references against the presently pending claims, the Applicants make the following remarks.

To establish a *prima facie* case of obviousness, an examiner must establish: (1) that some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) that the prior art references teach all the claim limitations and provide the necessary suggestion or motivation for combining the references. *Amgen*, 18 U.S.P.Q.2d at 1023; *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). A *prima facie* case of obviousness must also include a showing of the reasons why it would be obvious to modify the references to produce the present invention. *See Ex parte Clapp*, 277 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985). The Office bears the initial burden to provide some convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings. *Id.* at 974.

A. Ewing II Is Not Available As Prior Art Against the Present Application

The Applicants respectfully submit that Ewing II is not available as prior art against the present Application. Although the Official Action asserts Ewing II as a prior art reference, it is unclear which provision of 35 U.S.C. §102 the Office Action is relying upon to assert Ewing II as prior art. Since Ewing II is assigned to the same entity as the present application, and has the same inventors, it cannot qualify as prior art under §102(a) (which requires acts by “another”).

Ewing II issued on April 9, 1996. The present application is a continuation-in-part of application serial number 08/685,446 (hereinafter, “the ‘446 application”), filed July 23, 1996. Because the filing date of an application to which the present application claims priority is less than one year after the issue date of Ewing II, Ewing II does not qualify as prior art under 35 U.S.C. §102(b). The Applicants further note that, even though the present application is a continuation-in-part of the ‘446 application, the subject matter of Ewing II that is cited in the Official Action is fully supported by the specification of the ‘446 application as it was filed. In particular, the Official Action cites column 4, lines 3-16 of Ewing II in its §103(a) rejection. The identical disclosure appears at column 5, lines 54-67 of the patent that issued from the ‘446 application (U.S. Patent 5,949,974).

The Applicants further submit that §102(c) and §102(d) (which deal, respectively, with abandonment and prior patents in a foreign country) have no relevance in determining the availability of Ewing II as prior art. Section 102(e) deals with patents and patent applications filed by “another.” Since Ewing II and the present application share common inventors and a common assignee, Ewing II cannot be used as §102(e) prior art against the present application.

Finally, §102(g) deals with prior invention by another, which does not apply to the present situation. Because there are no provisions under which Ewing II qualifies as prior art, it may not be used as a reference under either §102 *or* §103(a) against Applicants' present application.

The Official Action states that Ewing II discloses "power-on sensing and load sensing." *See* Official Action at 9. By sensing, the Applicants assume that the Office meant that Ewing II discloses that such conditions were sensed and communicated (i.e., output or reported) to a separate device. For example, in the rejection of claim 17, the Official Action states that "Ewing II teaches a sensor for...reading and *reporting* any results that indicate a switched-on or switched-off condition." Page 10 (emphasis added). Even if Ewing II may have appeared to disclose power-on or load sensing and reporting, Ewing II is not available as prior art. Applicants are not aware of any art of record that provides power-on or load sensing and reporting.

Applicants have submitted an IDS containing information regarding Applicants' prior art "Versatimer" remotely programmable timing switch. As explained in the IDS, this remotely programmable timing switch contained certain features disclosed by Ewing II, but the Versatimer switch did not contain the aspects the Office asserted to be present in Ewing II. In particular, the Versatimer switch did not provide power-on or load sensing and reporting.

In order to defeat patentability under §103(a), the asserted combination of references must teach all of the limitations of the claims. MPEP §2143.03. Since Ewing II is not available as prior art, and no other reference supplies the missing elements, there is no combination of references that teaches all limitations of the Applicants' claims. The claims are therefore allowable over the remaining references as a matter of law.

B. The Office Has Not Rebutted Applicants' Arguments Establishing that Solutions '94 Is Not Enabling

The Applicants respectfully submit that Solutions '94 is not enabling of the features for which it is cited. The Official Action states that Solutions '94 teaches a network management system wherein the network manager communicates over a TCP/IP network with a remote node including a network agent (p. 31 Automatic shutdown/reboot; p. 30 SNMP which implicitly teaches TCP/IP.)” The Official Action also states that one of ordinary skill in the art would have inferred that this teaching could be applied to a generic power device, and not just a UPS. Applicants previously submitted that Solutions '94 is not enabling, both under established patent law and as shown by the Maskaly declaration.

i. The Maskaly declaration establishes that Solutions '94 is not enabling

As was discussed in Section V, the arguments of which are hereby incorporated in their entirety, the §103(a) rejections are improper under the Federal Circuit’s analysis in *Reading and Bates Construction*. 223 U.S.P.Q. 1168. Under *Reading*, a brochure may qualify as a prior art reference “only for what is disclosed in it.” “[T]he mere fact that the ...brochure, a one-page promotional brochure, boasts the ability and results of the [claimed] process of the ...patent is insufficient, as a matter of law, to constitute an enabling disclosure” *Id.* The Maskaly declaration establishes that Solutions '94 is not enabling.

The cited page of the Solutions '94 brochure merely boasts the ability and results of making a UPS “SNMP manageable” with an SNMP adapter for “Ethernet or Token Ring environments.” Mr. Maskaly states that merely listing the abilities of the device does not enable those abilities:

... Solutions 94 does not teach an ordinary artisan as recited by the Office Action above. Although the Solutions 94 ad does recite high level concepts for use of SNMP in power control apparatus, the Solutions 94 ad also is cursory and does not teach much if any of the mechanical, electrical, electronic or programming details for the desired power control apparatus. Like the Masterswitch ad, the Solutions 94 ad as a whole includes only limited external views of what the apparatus might look like, and it really does not include any “specification” at all for how to make the conceived apparatus. The entire pertinent disclosure in the Solutions 94 ad also is only a relatively few lines of textual objectives for the apparatus and very limited high level physical structure on the outside of a purported device.

If one skilled in the art were to seek to build a power control apparatus of the type recited in the Solutions 94 ad, the ordinary artisan would need to develop and engineer virtually every aspect of the desired device: all of its electrical, electronic, and programming structures and details, and virtually all mechanical structures and details, from scratch

The Solutions 94 reference therefore does not really “teach” an ordinary artisan how to make of use the claimed system without a great amount of effort by the artisan on his or her own

The Official Action states that Mr. Maskaly failed to consider all of the *Wands* factors. *See* Official Action at 16. The Official Action further states that, even if a *prima facie* case was established, that the declaration was defective because: it fails to establish that the amount of experimentation is atypical; it fails to discuss the state of the prior art; and it ignores the existence of a working example. However, as stated above in Section V, the *Wands* factors are not mandatory. *See Amgen, Inc.*, 927 F.2d at 1213. Accordingly, even if the Applicants had

failed to analyze every *Wands* factor, this alone is not enough to negate the Applicants' demonstration of the lack of enablement of Solutions '94. However, the Maskaly declaration does address the concerns stated in the Official Action.

As with Masterswitch, Mr. Maskaly's conclusion that Solutions '94 is not enabling is obviously informed by his consideration of the prior art because the two man year development time assumes an ordinarily skilled artisan, who presumably would be familiar with the prior art. The amount of experimentation is obviously undue because the two man years Mr. Maskaly estimates it would take to develop a device of Solutions '94 is the same whether or not Solutions '94 is considered because Solutions '94 provides no enabling disclosure. There is nothing in Solutions '94 that would reduce the amount of effort needed to develop the type of device described therein. Finally, using the understanding of "working examples" provided in Section V, there are, in fact, no working examples in Solutions '94. No information regarding the devices described by Solutions '94 has been provided, therefore any devices described by Solutions '94 cannot be asserted against the Applicants' claims. Since the Official Action contained nothing to rebut the Applicants' arguments and evidence, the Applicants respectfully submit that the Office has not established that Solutions '94 is enabling.

In response to the Maskaly declaration, the Official Action states that a number of previously cited, but not applied, references establish that devices described by Solutions '94 are within the skill of those in the art. The Official Action indicated that Davison "makes clear that the feature relied upon by the Examiner from the Solutions '94 reference (i.e., SNMP and TCP/IP control of power devices) is within the level of ordinary skill in the art, since it is the subject of a standards process." The Applicants respectfully disagree.

First, the level of ordinary skill in the art, is, as noted above, but one of many factors that must be considered. (*See In re Wands*). Moreover, whether SNMP and TCP/IP control of power

devices generally may within the level of ordinary skill is not dispositive of whether the particularly claimed features of the present invention would be obvious to one of ordinary skill in the art.

The present invention, as claimed in independent claim 6, is directed to an apparatus wherein an IP message is independently communicated for at least one of power-on sensing, load sensing, power cycling on/off, and tickle signal generation. Independent claim 21 is directed an apparatus having a power manager agent application to provide power cycling on-off of a corresponding power outlet in response to one or more commands. A feature of both of these claims is that they involve *active* communication with an intelligent power module.

In contrast, Davison merely “defines the managed objects for Uninterruptible Power Supplies which are to be manageable via the Simple Network Management Protocol (SNMP). *See* page 4. Davison defines static attributes that can be monitored over an SNMP network, such as “ident,” “battery,” “input,” and “output,” among others. As an example of the function of one of these attributes, the “battery” attribute includes the estimated time to battery charge depletion, battery temperature, battery voltage, battery charging current, battery discharging current, and current battery capacity as a percentage of total capacity.

Davison does not, however, disclose any *active* communication interaction with an intelligent power module, such as is claimed in independent claims 6 and 21, whereby a message, such as an IP message, can be independently communicated to one or more of a plurality of intelligent power sections to support independent control of each of the plurality of intelligent power sections for at least one of power-on sensing, load sensing, power cycling on/off, and tickle signal generation as presently claimed.

The Official Action further asserts that the cited, but not applied, Internetworking Labs reference “evidences that the product being tested is within the level of skill in the art.” The

Applicants respectfully disagree and submit that Internetworking Labs does not establish that the particularly claimed features of the instant invention would be obvious to one of ordinary skill in the art. Internetworking Labs merely states that the disclosed test suite allows one to “isolate SNMP-related bugs” and “verify compliance with the SNMP protocols”. Nowhere does Internetworking Labs suggest, much less teach, active communication with intelligent power modules.

The Official Action further states that the cited, but not applied, Merling Gerin reference “teaches individualized SNMP control over receptacles in a UPS at pages 5-7” and that together the non-applied “references suggest that the features relied upon from the Solutions ’94 reference are within the level of ordinary skill in the art.” Official Action at 15. However, Merling Gerin does not teach active communication with an intelligent power module, as claimed by Applicants.

Merling Gerin, like Davison, merely defines “objects for the description of the receptacles of the UPS.” *Id.* at 5. Merling Gerin defines three discrete object groups related to a UPS receptacle, such as “ReceptaclesNum,” the total number of receptacles controlled by the UPS. Associated with each receptacle entry are additional attributes, such as those that assign an index number to each receptacle (mgreceptacleindex) or provide an on/off state indicator (mgreceptaclestate). With respect to the attribute “mgreceptaclestate”, Merling Gerin, like Davison, merely defines static attributes that can be monitored over an SNMP network reflecting the current condition of the receptacles (such as manual on, manual off, normal on after restart sequence, and the like.) *See* page 7. Nowhere in Merling Gerin is there disclosed active communication interaction with an intelligent power module whereby a message can be independently communicated to one or more of a plurality of intelligent power sections to support independent control of each of the plurality of intelligent power sections for at least one

of power-on sensing, load sensing, power cycling on/off, and tickle signal generation, as presently claimed. Because the Maskaly declaration establishes that Solutions '94 is not enabling of the features for which it is cited, it may not be used in a §103(a) rejection of the Applicants' presently pending claims.

- ii. Established patent law provides that promotional brochures lacking a detailed description of the underlying technology are not enabling.

The MPEP and court decisions make clear that scant disclosures of the type of Solutions '94 (and Masterswitch) are not enabling. For example, MPEP 2164.06 notes that mere functional "block diagrams" are often insufficient to enable a person skilled in the art to practice a claimed invention without undue experimentation. Regarding an illustrative case in the computer arts, the MPEP notes that the subject application was held non-enabled because:

many of the components which appellants illustrate as rectangles in their drawing necessarily are themselves complex assemblages.... It is common knowledge that many months or years elapse from the announcement of a new computer by a manufacturer before the first prototype is available. This does not bespeak of a routine operation but of extensive experimentation and development work.

See MPEP §2164.06, citing *In re Ghiron*, 169 U.S.P.Q. 723, 727-28 (C.C.P.A. 1971). In *Ghiron*, the specification did not particularly identify each of the elements represented by the blocks or the relationship therebetween, nor did it specify particular apparatus intended to carry out each function. *See id.* The Board also questioned whether the selection and assembly of the required components could be carried out routinely by persons of ordinary skill in the art. *See id.* An adequate disclosure of a device may require details of how complex components are constructed and perform the desired function.

In the present case, the cited page of the Solutions '94 brochure provides even less detail than the non-enabling disclosure at issue in *Ghiron*. Solutions '94 does not even provide any block diagrams - it merely shows a picture of a UPS and a separate picture of a so-called

interface card. Anyone attempting to actually build the disclosed device would have to engineer every aspect of the device from scratch. *See id.*

The textual materials of the brochure's specification do not particularly identify each of the elements in the pictures or the relationship therebetween. No information is provided as to how the interface card interfaces to the power module, or circuit modifications to the power module in order to enable it to interface to the SNMP interface, or how a network manager communicates to an SNMP network agent via the SNMP interface card. Solutions '94 provides no disclosure of the SNMP interface's circuit design. Solutions '94 does not specify which apparatus is intended to carry out the various SNMP functions. Solutions '94 provides no disclosure what-so-ever of the ability to use the SNMP interface in a TCP/IP environment. Solutions '94 is utter lacking any schematics or logic-flow diagrams that would provide even the most basic guidance of how to construct the disclosed device.

Similarly, MPEP 2164.06 further notes that a mere disclosure of an electrical circuit apparatus, depicted in drawings by block diagrams with functional labels, has been held nonenabling since there was no indication in the specification as to whether the parts represented by boxes were "off the shelf" or must be specifically constructed or modified for applicant's system. An additionally deficiency of Solutions '94 is that it provides no details of how the parts should be interconnected, timed, and controlled so as to obtain the specific operations claimed by Applicants. *See In re Gunn*, 190 U.S.P.Q. 402, 406 (C.C.P.A. 1976). Whereas in *Gunn* the non-enabling specification relied upon stock components, Solutions '94 is even less enabling because the parts represented by the purported SNMP interface must be specifically constructed and the UPS suitably modified to connect thereto. No details of these parts are provided and, like *Gunn*, there are no details in Solutions '94 of how the parts should be interconnected, timed, and controlled so as to obtain the specific operations desired. *See also, In re Scarbrough*, 182

U.S.P.Q. 298 (C.C.P.A. 1974) (a system which comprised several component parts (e.g., computer, timing and control mechanism, A/D converter, etc.) only by generic name and overall ultimate function was found non-enabling because (i) the specification did not describe how “complex elements known to perform broadly recited functions in different systems would be adaptable for use in Appellant’s particular system with only a reasonable amount of experimentation” and (ii) “an unreasonable amount of work would be required to arrive at the detailed relationships appellant says that he has solved.”) Accordingly, the Solutions ’94 brochure is non-enabling.

Finally, and in further support of the non-obviousness of the presently claimed invention, Applicants submit as Exhibit C a copy of the Declaration of inventor Carrel W. Ewing, which was submitted in reexamination proceeding 90/006,097. Mr. Ewing identifies how the market share of Server Technology, Inc., has grown since its inception, largely as a consequence technologies that are the subject of the pending application. Revenue from relevant products increased from \$94,035 in 1997 to \$11,044,928 in 2001. As a percentage of Server Technologies total revenue, relevant products increased from 3.6% in 1997 to 87.5% in 2001. The striking commercial success of Server Technologies’ relevant products establish that such products were not obvious.

CONCLUSION

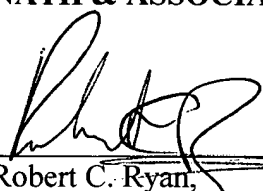
Accordingly, and in view of all the above, Applicants respectfully submit that a prima facie case of obviousness has not been established and therefore respectfully submit that presently pending claims 6-38 are patentable over the prior art of record.

Respectfully submitted,

NATH & ASSOCIATES PLLC

Dated: June 18, 2004
1030 15th Street N.W., 6th Floor
Washington, D.C. 20005
775-824-0104 (Tel)
775-824-0107 (Fax)

By: _____


Robert C. Ryan,
Registration No. 29,343
Marvin Berkowitz
Registration No. 47,421
Customer No. 20529



Dec-18-1996

APC Rescinds Stock Repurchase Program

Dec-3-1996

APC Welcomes Sun Microsystems Inc. to 'ProtectME! with APC' Joint Marketing Program

Nov-18-1996

APC brings power to the World Wide Web with it's MasterSwitch E515 network manageable power distribution unit

Nov-18-1996

APC Bundles Award Winning Power Management Software with Smart-UPS for Single Box Convenience at up to 15% Savings over Separate Solutions

Nov-18-1996

APC Announces PowerChute plus v5.0 with Web based UPS management for Windows NT

Nov-18-1996

APC increases breadth and depth of PowerAudit consulting service due to extraordinary demand

Nov-18-1996

APC introduces the PowerView UPS Management Module: Palm-sized UPS monitoring and control for LAN administrators

Nov-13-1996

APC's Smart-UPS(R) 1000 Selected PC Magazine's 'Editors' Choice'

Nov-5-1996

Reseller loyalty powers APC in VARBusiness Report Card

Nov-4-1996

APC's New Back-UPS Office Wins Acclaim

Oct-30-1996

APC Welcomes ALR to 'ProtectME! With APC' Joint Marketing Program

Oct-24-1996

APC Announces Record Results, Earnings up 63% & Sales up 36%

Oct-15-1996

APC Protects Microsoft South Africa's Guinness World Record NT Network

Sep-26-1996

APC Wins PC Quest Users' Choice Award in India

Sep-16-1996

NEC to bundle APC Power Protection with new line of PCs

Sep-3-1996

APC Enhances Matrix-UPS to Include Complete Customizable Power Management Solution for the Datacenter

Aug-26-1996

APC brings power to the World Wide Web with it's MasterSwitch E515 network manageable power distribution unit

- The first remote power switching device featuring embedded Web management
 - Built in 10BT ethernet interface
 - Integrated network management via SNMP or HTTP of 8 independent power channels
 - Rack mounted form factor for easy installation in APC's NetShelter(TM) server enclosures
 - Can be used with or without a UPS

WEST KINGSTON, R.I., Nov. 18 /PRNewswire/ -- American Power Conversion (Nasdaq: **APCC**) today announced it's MasterSwitch(TM) E515 network manageable power distribution unit (PDU). The MasterSwitch(TM) E515 gives the network administrator complete control over the power to his connected equipment. From anywhere on the network, the administrator can use his network management station (NMS) or Web browser to power, de-power or reboot computers and internetworking equipment.

The MasterSwitch(TM) E515 provides 8 relay controlled outlets. Each outlet provides independent switching of the connected load, allowing remote control of the load's power without affecting other equipment attached to the device. Potential applications for this device include remotely located racks of servers or internetworking equipment or banks of modems that occasionally need to be rebooted.

"On-site service calls to a remote site cost a lot of money," said Bob Thurston, Product Manager for the MasterSwitch(TM) PDU, "There's nothing more frustrating for our customers than having to send a field tech to a remote site just to reboot a locked-up server or router. APC has tried to answer the customer's problem by giving them a tool to allow them to manage their network much more cost effectively. The MasterSwitch(TM) E515 allows the customer to reboot or de-power equipment from the central site. With on-site service calls approaching \$300 per visit, the MasterSwitch(TM) E515 pays for itself almost immediately."

As expected, APC provides SNMP management for the MasterSwitch(TM) E515. By extending industry standard MIB-2 compliance to include it's proprietary MIB for controlled outlets, APC has further expanded the SNMP user's ability to manage his network. The device can be managed alongside APC's UPSes via any standard SNMP management station or MIB browser.

Looking to the future, APC has also provided embedded Web manageability. The embedded Web server provides full control of the PDU using an intuitive, graphical interface. The interface was designed with low bandwidth applications in mind and is suitable for dial-up lines. Security is provided using the HTTP 1.0 password standard. User configurable URL links are provided to tie the PDU to it's connected loads or to other managed devices on the network. Additionally, static URL links provide a direct connection to APC's home page, giving the user product and technical support.

Configuration of the PDU is facilitated over the network or via a RS-232 terminal interface. The MasterSwitch(TM) E515 also supports Bootp for automatic IP address assignment.

The MasterSwitch(TM) E515 is APC's next stepping stone in affording the LAN manager complete control of his network environment. It eases the burden of managing remote sites and maximizes the uptime of servers and internetworking equipment.

Product Benefits Include:

- Built in Ethernet interface for direct connection to the customer's LAN.
- Network manageable by the Web and SNMP for seamless integration into the customer's present and future network management strategies.
- Serial interface for off-line configuration and diagnostics.
- Eight independent power channels for complete and flexible management of connected equipment.
- Front panel LED's provide a quick status check of powered loads.

This new product, with mounting brackets, is 1.875 x 19 x 6.5 inches, and weighs 6.5 pounds. Eight NEMA 5-15 outlets, supply a maximum total current draw of 15 A. The MasterSwitch(TM) E515 will be available to ship on February 3, 1997. Initial list pricing is expected to be \$599.

The MasterSwitch(TM) E515 is UL and CSA listed and FCC verified.

American Power Conversion (Nasdaq: **APCC**) is the market share leader in Uninterruptible Power Supplies (UPS) and software for networks and similar mission-critical applications. Product lines include the Back-UPS(R), Smart-UPS(R), Matrix-UPS(TM), PowerShield(TM) UPS, Line-R(TM) power conditioners, SmartSlot(TM) UPS accessories, MasterSwitch(TM) PDUs, PowerChute(R) software, PowerNet(TM) SNMP adapters and software, SurgeArrest(R) surge suppressors, ProtectNet(TM) data-line surge suppressors, and PowerManager(T) PowerCenters.

American Power Conversion is an affirmative action/equal opportunity employer. (All trademarks are the property of their owners)

SOURCE American Power Conversion

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ROBERT RYAN

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PAGE 03

P.01

IN THE UNITED STATES PATENT TRADEMARK OFFICE

5 In re application of: Ewing et al.)
Serial number: 09/375,471) Before Examiner Caldwell
Filed: August 16, 1999) Group Art Unit 2154
10 Title: REMOTE POWER CONTROL) Attorney Docket No. MLF 600.06
SYSTEM)



15 DECLARATION OF JAMES P. MASKALY UNDER 37 C.F.R. § 1.132

Assistant Commissioner for Patents
P.O. Box 1450
20 Alexandria, Virginia 22313-1450

Dear Assistant Commissioner for Patents:

I, James Maskaly, the undersigned, hereby submit this Declaration upon personal
25 knowledge in connection with this, the above-identified, patent application by Carrel Ewing et al
("the Ewing patent application").

1. I presently reside at 1568 Topeka Circle, Sparks, Nevada 89434.
2. I earned a Bachelor of Science in Electrical Engineering from the University of Nevada
Reno ("UNR") in 1987. I learned about TCP/IP and its use in connection with networking in
30 general during my education at UNR.
3. From mid-1987 until about May, 2000, I was employed as an electrical design engineer at
Scientific Engineering Instruments, Inc., of Sparks, Nevada, developing electronic
instrumentation for power plants.
4. In May, 2000, I became employed by the owner of the Ewing patent application, Server
35 Technology, Inc., as an electrical design engineer, primarily involved in designing hardware and

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ROBERT RYAN

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In re application of: Ewing et al
Serial Number 09/375,471
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firmware remote control power systems, including networked systems. I have been employed in this capacity ever since.

5. I have reviewed the Ewing patent application, the Office Action mailed in this case December 10, 2002, and the Masterswitch and Solutions 94 advertisements cited in that Office
5 Action.

6. I believe that I am an expert, and in any event at least of the skill level of an ordinary artisan, in the field of power systems technology in general and in particular in the field of the type of power systems technology disclosed in the this patent application.

7. The above-identified Office Action rejected claims 6, 10, and 12 as being anticipated by
10 the Masterswitch advertisement. The Office Action did not offer a detailed explanation of the basis of this rejection.

8. In my opinion, even if the Masterswitch ad is assumed to be prior art, it does not teach an ordinary artisan how to both make and use the features of the claims 6, 10, or 12 such as power-on sensing, load sensing, power cycling, or tickle signal generation. Although the Masterswitch
15 ad does recite high level concepts for a power control apparatus, the Masterswitch ad is extremely cursory and does not teach much if any of the mechanical, electrical, electronic, or programming details for the desired power control apparatus. The Masterswitch reference as a whole includes only limited, vague external views of what the apparatus might look like, and it really does not include any "specification" at all for how to make the conceived apparatus. The
20 entire pertinent disclosure in the Masterswitch ad is only a relatively few lines of textual objectives for the apparatus and very limited high level physical structure on the outside of a purported device.

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In re application of: Ewing et al
Serial Number 09/375,471
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9. If one skilled in the art were to seek to build a power control apparatus of the type recited in the Masterswitch ad, the ordinary artisan would need to develop and engineer virtually every aspect of the desired device: all of its electrical, electronic, and programming structures and details, and virtually all mechanical structures and details, from scratch. I estimate the amount of time required for ordinary artisans to build a device of the type disclosed in the reference, and asserted to fall within the claims 6, 10, and 12 in the Office Action, would require at least two (2) man years of engineering and development effort.
10. The Masterswitch reference therefore does not really "teach" an ordinary artisan how to make or use the claimed system without a great amount of effort by the artisan on his or her own.
- 10 The Masterswitch reference really only discloses a high level concept for a power control apparatus, without disclosing any information, other than the high level concept, required by the ordinary artisan to make and use the desired system.
11. The above-identified Office Action rejected claims all remaining claims as being obvious over the Solutions 94 advertisement. The Office Action stated, for example:
- 15 14. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Ewing I and II to modify its modern based communication to use the SNMP and TCP/IP protocols as taught by Solutions '94. This modification would have been obvious based on Solutions '94's explicit teaching on page 33 that use of SNMP as opposed to proprietary protocols allows for the easy integration of power information into popular network management systems, thus reducing the number of separate management applications a network manger would need to run.
- 20 15. As to the limitation of a network agent, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine an SNMP agent with the power manager of Ewing I because an agent is a necessary feature of an SNMP-compliant managed device.
- 25

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12. In my opinion, Solutions 94 ad does not teach an ordinary artisan as recited by the Office Action above. Although the Solutions 94 ad does recite high level concepts for use of SNMP in power control apparatus, the Solutions 94 ad also is cursory and does not teach much if any of the mechanical, electrical, electronic, or programming details for the desired power control
- 5 apparatus. Like the Masterswitch ad, the Solutions 94 ad as a whole includes only limited external views of what the apparatus might look like, and it really does not include any "specification" at all for how to make the conceived apparatus. The entire pertinent disclosure is the Solutions 94 ad also is only a relatively few lines of textual objectives for the apparatus and very limited high level physical structure on the outside of a purported device.
- 10 13. If one skilled in the art were to seek to build a power control apparatus of the type recited in the Solutions' ad, the ordinary artisan would need to develop and engineer virtually every aspect of the desired device: all of its electrical, electronic, and programming structures and details, and virtually all mechanical structures and details, from scratch. I estimate the amount of time required for ordinary artisans to build a device of the type disclosed in the reference, and
- 15 asserted in the Office Action, would require at least two (2) man years of engineering and development effort.
14. The Solutions 94 reference therefore does not really "teach" an ordinary artisan how to make or use the claimed system without a great amount effort from the artisan on his or her own. The Solutions 94 reference really only discloses a high level concept for a power control
- 20 apparatus, without disclosing any information, other than the high level concept, required by the ordinary artisan to make and use the desired system.

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ROBERT RYAN

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In re application of: Ewing et al
Serial Number 09/375,471
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15. I state under penalty of perjury that the foregoing is true and correct.

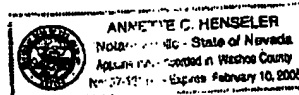
Executed in Reno, Nevada, on this 2d day of July, 2003.

5

James P. Maskaly
James P. Maskaly

Subscribed and sworn to before me by Annette C. Henseler, personally known to
10 me, this 2d day of July, 2003.

Annette C. Henseler
Notary Public



5



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: C. EWING, et al.

Serial No.: 10/806,130

Filing Date: March 23, 2004

For: REMOTE POWER CONTROL SYSTEM

COMMISSIONER OF PATENTS
& TRADEMARKS
Washington, D.C. 20231

DECLARATION OF CARREL W. EWING

I, Carrel W. Ewing, declare and affirm that I am the first named inventor of previously filed continuation application 10/806,130. I also am the founder and chief executive officer (CEO) of the assignee of the present continuation application, Server Technology, Inc., (STI, www.servertech.com, see portion attached as Exhibit A). As the CEO of STI, I have supervised and managed STI's activities since it was formed in August 1984, and I am very familiar with all STI products (present and past), the purposes for which they have been sold, and the uses to which they are most often put by users in the field.

I have studied the present continuation application. I have determined the particular STI products that are covered by the claims in the present continuation application.

In this regard, as I will explain in greater detail below, each of the claims 6-38 is directed to an apparatus having, among other things, a power control apparatus with

power outputs, intelligent power modules, a power manager agent application, and network power manager applications (with each of these elements being described in further and varying detail in the differing claims 6-38 in the present application). As explained in greater detail below, in my opinion: (i) these particular STI products provide the claimed subject matter for the user; and (ii) as a result of providing the claimed subject matter for the users, these particular STI products have achieved substantial commercial success. As also explained in greater detail below, these same STI products, and these same STI product sales (i.e., those that provide the user with the claimed subject matter of claims 6-38) have been the core of STI's growing business and its dominant source of revenue for years, as also further shown below.

In order to help assist in understanding Server Technology's products, their use, and the benefits they provide to those who use them, copies of STI datasheets and product brochures were included in the previously submitted Information Disclosure Statement and accompanying form 1449.

Referring now to independent Claim 6 as an example, it claims an apparatus comprising:

- (a) a power supply housing;
- (b) a power manager agent application mounted in association with the housing and being connectable to the network communications connection;
- (c) a plurality of power outlets mounted in the power supply housing;
- (d) a plurality of intelligent power modules mounted in the power supply housing and connectable to said network communications connection and thereby being in IP communication with said network power manager application through said power manager agent application, each said intelligent power module being adapted to provide power from a power source to a corresponding power outlet among the plurality of power outlets and being in communication with said power manager agent application to provide power cycling on-off of said corresponding

power outlet and at least one of power state sensing and load-sensing with respect to said corresponding power outlet in response to one or more commands.

Server Technology's products that include the claimed subject matter of independent Claims 6, 21, and 36 are sold under Server Technology's SENTRY trademark. They include the following models: R-2000; R-2020; 48-VDC, Power Tower; R-400, and R-450. Independent claim 21 also covers Server Technology's Ambassador product.

The SENTRY Ambassador is a 1996 vintage product, now with declining sales. (See, reference document AA.) It supports up to twelve distributed power modules from a seven-inch mini-tower cabinet. The AMBASSADOR includes the subject matter of claims 21-24, 27, and 28.

The SENTRY R-2000, introduced in 1996, is a size-2U 19" rack mount enclosure with eight integrated IPM's and associated AC power-output receptacles that support a 30-amp, 110 VAC power load (or a 12-amp, 230 VAC load), and also supports up to eight distributed power modules. (See, reference document AB.) Its password-protected interface screens can be accessed by any terminal emulation application. Users can control each AC power receptacle, and can be individually powered on, powered off, or automatically rebooted. The SENTRY R-2000 supports modem (out-of-band) communication sessions, and RS-232 console and 10-BaseT Ethernet in-band communications sessions. The SENTRY R-2000 is covered by Claims 6-9, 12-13, 21-24, 27-28, and 36-38.

The SENTRY R-2020 is a high amperage version of the R-2000 that can support four integrated IPM's and associated individually controllable 16-amp in/out power-output distribution receptacles, and supports up to twelve distributed power modules.

(See, reference document AC.) This product was introduced in 1998. The SENTRY R-2020 is covered by Claims 6-9, 12-13, 21-24, 27-28, and 36-38.

The SENTRY -48VDC series, model 4820 for example, has two 60-to-100 Amp power input feeds supporting dual power supply networking equipment units, 4-to-8 integrated IPM's, and associated 20-Amp power outlets. There are 25-Amp circuit breakers on each power outlet circuit, and a space-efficient 19" 2U rack-mounted unit is used which eliminates the need for a separate power distribution panel. The SENTRY -48VDC series is typically used with routers, DSLAMs, ATM switches, DC-powered servers, data communications and other telecom equipment units. (See, reference document AD.) Pull-to-break/Push-to-reset circuit breakers may be used as on-site on/off power switch. The SENTRY XL models include load sense, on-sense and temperature sense, and a LAN interface that supports Telnet, HTML (web browser) interface, and SNMP with traps. This product was introduced in 1998. The SENTRY -48VDC series is covered by Claims 6-14, 21-29, and 36-38.

A testimonial letter regarding the SENTRY -48VDC product from a large and sophisticated customer, Bell South, is attached as Exhibit I.

The POWER TOWER products are SENTRY-type power managers and integrated IPM's configured inside a long plugstrip. (See, reference document AG-AJ.) The SENTRY Expanded Function Power Tower™ (PTEF) is designed for data centers, co-lo sites and other lights-out facilities. It occupies zero-U of valuable rack space, and provides advanced power distribution & measurement with remote management via TCP/IP. The SENTRY Serial Power Tower™ model allows you to leverage existing infrastructure to add remote power management. This unit complements an existing

input serial device such as a terminal-server and completes the approach for true remote management of light-out facility or an in-house data center. The SENTRY POWER TOWER is covered by Claims 6-9, 12-13, 21-28, and 36-38.

The SENTRY R-400 COMMANDER has four integrated AC-power output receptacles. (See, reference document AK.) Up to four distributed power modules are used to support 80-amps more load. The SENTRY R-400 is covered by Claims 6-9, 12-13, 21-24, 27-28, and 36-38.

The SENTRY R-450 ADMINISTRATOR has no integrated power receptacles. It, like the R-400 COMMANDER, can support as many as sixteen distributed power modules. (See, reference document AM.) The SENTRY R-400 is covered by Claims 6-9, 12-13, 21-24, 27-28, and 36-38.

SENTRY R-2000, R-2020, 48-VDC, R-400, and R-450 products can be chained together to manage up to 104 individual pieces of network equipment with a single communications connection. (See, reference document AB-AD, and AL-AM.)

Server Technology's sales revenues through 2003 for products covered by independent claims 1 and 31 (i.e., for all products noted above other than the Sentry Ambassador product) are summarized in the Table 2.

Table 2

Server Technology, Inc.
Product Sales by Product Line
Fiscal Years Ended September 30,

	<u>1997</u>	<u>1998</u>	<u>1999</u>	<u>2000</u>	<u>2001</u>	<u>2002</u>	<u>2003</u>
Patent technology:							
R2000	94,035	1,107,551	972,710	1,977,153	2,419,860	655,891	339,514
R2020	-	-	644,481	291,379	354,006	133,073	115,159
48VDC	-	181,376	1,845,782	5,785,404	6,611,693	1,809,854	1,200,006
Power Tower	-	-	-	-	142,320	2,056,246	3,514,436
R400	-	170,035	462,749	637,248	519,909	723,925	574,449
R450	-	-	296,811	1,349,577	997,140	989,494	726,357
Patent technology products	94,035	1,458,962	4,222,533	10,040,761	11,044,928	6,368,483	6,469,921
Other products	2,496,523	2,111,958	1,711,322	1,552,969	1,585,024	838,168	1,847,481
Total sales	2,590,558	3,570,920	5,933,855	11,593,730	12,629,952	7,206,651	8,317,402
Patented products as a % of total	3.6%	40.9%	71.2%	86.6%	87.5%	88.4%	77.8%

The corresponding sale numbers for the Sentry Ambassador, which is covered by independent claim 21, were:

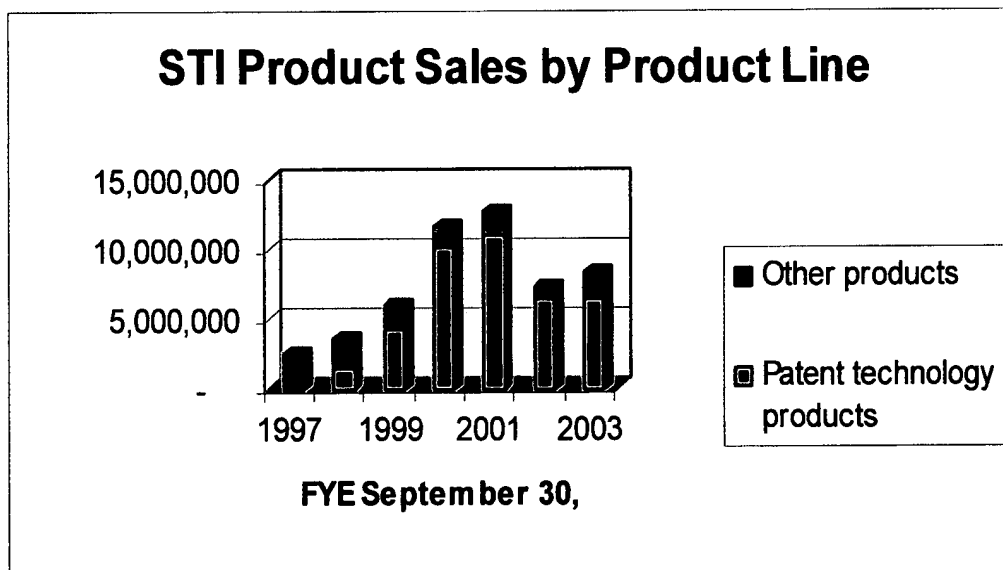
<u>1997</u>	<u>1998</u>	<u>1999</u>	<u>2000</u>	<u>2001</u>	<u>2002</u>	<u>2003</u>
140,586	489,965	414,434	124,252	79,105	7,734	10,702

In order simplify this Declaration, the following discussion addresses those Server Technology products identified in Table 1 above. That is, the following discussion focuses on those Server Technology products that are covered by all independent claims; it does not include the SENTRY Ambassador, which is not covered by independent claims 6 or 36.

As shown above and in Table 3 below, Server Technology's sales of the Server Technology products embodying the claimed subject matter of all independent claims (shown as "Patent technology products") has grown substantially year-by-year from \$94,035 in 1997, representing 3.6% of our total sales at that time, to \$11,044,928 in 2001,

representing 87.5% of our total sales. Our company experienced a drop in all sales during the national recession of 2002 and accompanying reduced economic activity throughout most of 2002 and 2003, but our sales of products embodying such claimed subject matter represented 88.4% and 77.8%, respectively, of our sales in 2002 and 2003. (These numbers increase of course if the Sentry Ambassador sales numbers are added in.) We believe that our overall sales in 2004 will achieve the levels reached in 2001 prior to the economic slowdown of 2002-03.

Table 3



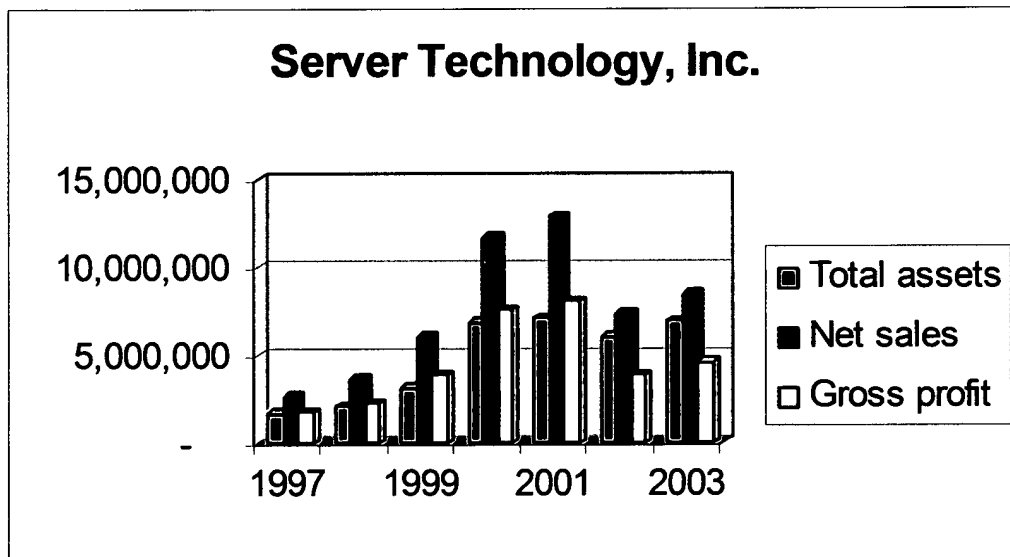
As a result of the commercial success of Server Technology patent technology products as shown above, Server Technology has also grown dramatically, and grown much more profitable, as a direct result, as shown in Table 4 and its graph in Table 5.

Table 4
Server Technology Assets, Sales, and Profits in Dollars

Server Technology, Inc.
 Select Financial Information
 Fiscal Years Ended September 30,

	<u>1997</u>	<u>1998</u>	<u>1999</u>	<u>2000</u>	<u>2001</u>	<u>2002</u>	<u>2003</u>
Total assets	1,663,498	2,055,649	3,141,503	6,857,920	7,054,097	6,031,403	6,968,993
Net sales	2,646,135	3,640,846	6,043,951	11,736,546	12,934,544	7,367,404	8,505,473
Gross profit	1,703,479	2,221,384	3,884,521	7,544,569	8,057,651	3,899,154	4,561,837

Table 5
Graph of Assets, Sales, and Profits



During the same period of time, and as a direct result of the commercial success of Server Technology products embodying the claimed subject matter in issue in this case, Server Technology's facilities have grown dramatically from 1,500 square feet in 1997, to our present 30,000 square foot facility. (See Exhibits B and C showing photographs of the STI's 1997 and 2001 facilities respectively.) During the same period

of time and also as a direct result of the commercial success of Server Technology products relevant here, Server Technology's employee headcount has nearly doubled from 20-employees in 1997, to 50 employees as of the date of this Declaration.

With regard to the market for Server Technology products, Server Technology has several competitors. The small, private companies we compete with are Bay Technical Associates, Inc. (<http://www.baytech.net/cgi-private/product>, a portion of which is attached as Exhibit D) located in St. Louis, MO; Western Telematic, Inc. (<http://www.wti.com/>, a portion of which is attached as Exhibit E) located in Irvine, CA; and, Pulizzi Engineering, Inc. (<http://www.pulizzi.com/>, a portion of which is attached as Exhibit F) located in Santa Ana, CA.

A small division of American Power Conversion Corporation (<http://www.apc.com>, a portion of which is attached as Exhibit G) is our only large-corporation competitor. The relevant products are listed under the "Power Management" category of their products webpage (<http://www.apc.com/products/index.cfm>, attached as Exhibit H).

I am not aware of any formal studies of this market. And so, I am not aware of any third party objective sources that would show the market size, growth, or which competitors lead the market and by how much. I therefore rely on my own observations and extensive experience to judge this market and our performance in it.

Based on my substantial professional, first-hand experience in this market that began before 1984, I estimate that the product sales volumes of Bay Technical Associates to be on the same scale as Server Technology's, at about \$10M-20M annually for products competitive with relevant Server Technology products.

I estimate the total product sales volumes of Western Telematic to be about twice Server Technology's, but only \$5M-\$10M of Western Telematic's sales appear to be for products competitive with Server Technology products relevant here.

I estimate that Pulizzi Engineering sales are on the same scale as Server Technology's, at about \$10M-20M. Of this amount, I estimate that up to 15% of their sales are for products competitive with Server Technology products relevant here.

I estimate that American Power Conversion has approximately \$50M a year in sales that compete with the relevant Server Technology products listed herein.

I therefore judge the annual worldwide sales volumes in this market to presently be about \$100M per year, and our share to be about 10-15%. Server Technology's sales growth averaged 50% per year from 1997-2001, so Server Technology's market share grew rapidly. I believe the principal reason for the rapid sales growth and market penetration by Server Technology is that its products, and particularly the products embodying the claimed subject matter, provide our customers with unique, cutting edge features.

Server Technology's products have such strong technical appeal to its customers, as evidenced in the Bell South testimonial letter attached as Exhibit I. This technical strength has manifested in unusually low costs of advertising and other marketing incurred by the Company, in my opinion. As seen in the graph of Table 6 and chart in Table 7, the advertising and marketing expenses over the last several years have been a relatively small percentage of gross sales revenue. In my opinion, the commercial product success and company growth have been due to the unique system combinations we claim in the present patent application. In my opinion, the products have their own

"market pull," and we have not had to spend much to generate "market push" through advertising.

Table 6

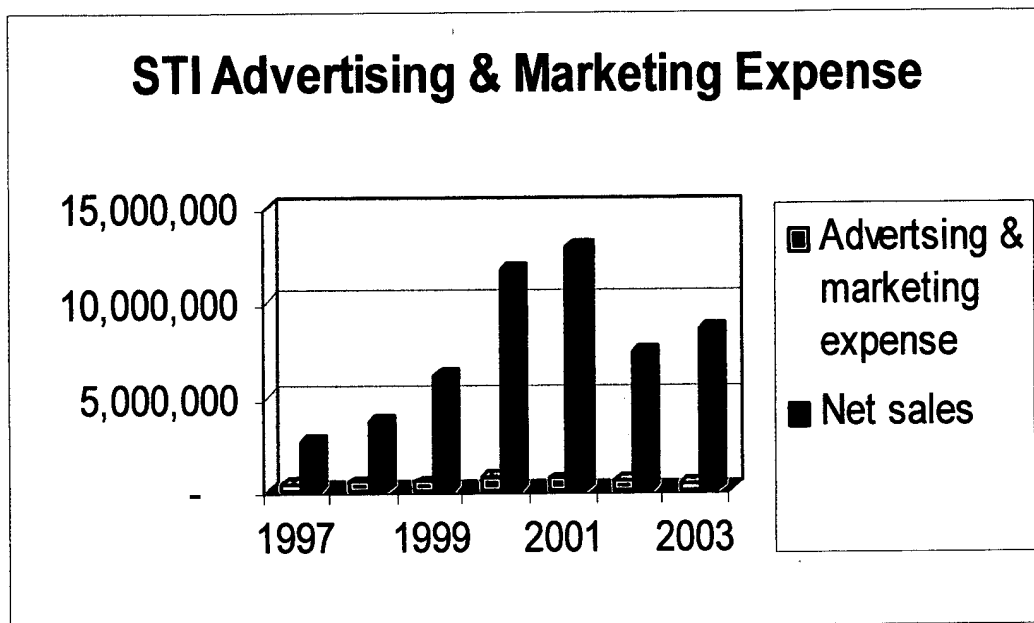


Table 7
Advertising and Marketing Expense
as a Percentage of Net Sales

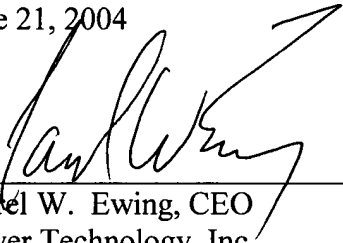
	<u>1997</u>	<u>1998</u>	<u>1999</u>	<u>2000</u>	<u>2001</u>	<u>2002</u>	<u>2003</u>
Adv. & mkting. exp. as a % of net sales	14.0%	11.2%	6.9%	5.4%	4.6%	6.4%	4.7%

In summary, the Server Technology products embodying the claimed subject matter as described above have become highly commercially successful and profitable products, and this commercial success is, in my opinion, primarily the result of the novel features and advantages provided by the claimed subject matter of pending independent claims 6 and 21 in particular. That is, this commercial success of the products noted

above is, in my opinion, primarily the result of the IP networking and remote power management features provided by the apparatus of claim 6 and of claim 21 but also included with the subject matter of all other claims 7-20 and 22-38.

I declare under penalty of perjury that the foregoing is true and correct.

June 21, 2004



Carrel W. Ewing, CEO
Server Technology, Inc.
Reno, Nevada

Support Document List transmitted with IDS
(All are publications of Server Technology, Inc.)

- AA. SENTRY Ambassador
- AB. SENTRY R-2000 Remote Power Manager © 2001
- AC. SENTRY 110/230 VAC Product Family © 2000
- AD. SENTRY Power Manager -48 VDC Product Family © 2000
- AG. SENTRY Power Tower Products © 2001/2002
- AH. SENTRY Expanded Function Power Tower (PTEF) © 2001/2002
- AI. SENTRY Serial Power Tower (PTSS) © 2001/2002
- AJ. SENTRY Power Tower Power Distribution © 2001/2002
- AK. SENTRY Commander R-400 Remote Power Mgr. © 2001/2002
- AL. SENTRY Commander R-400 Remote Pwr. Mgr. datasheet © 1999
- AM. SENTRY Administrator R-450 © 2001/2002
- AN. SENTRY Administrator R-450 Remote Pwr. Mgr. © 1998

EXHIBIT A

Information posted on Server Technology's web site as of September 2002:

www.servertech.com

Server Technology designs and manufactures Sentry Remote Power Management products that combine Intelligent Power Distribution, Power Measurement and Remote Power Management into a single solution. The Sentry integrated solutions increase network performance by eliminating the downtime from locked-up internetworking equipment and by extending measurement and monitoring of remote equipment units. Measurement features include monitoring the current draw (amperage) of each device in a remote relay rack or equipment cabinet, voltage availability and the temperature in remote sites. Sentry units also provide console port access to remote servers and network equipment.

Company Information

Server Technology, Inc. was founded in 1984 and has since become the leader in Remote Power Management technology, manufacturing a line of remotely addressable power switches called the Sentry™ Remote Power Managers. Available for both AC and DC power supply, Sentry products enable remote power control (off, on, reboot, graceful shutdown) of servers and internetworking devices in remote equipment rooms, POP sites, Telco central offices and other co-location facilities.

Server Technology is located in Reno, Nevada, where we develop, manufacture, market and provide technical support for each product.

Our Mission Statement

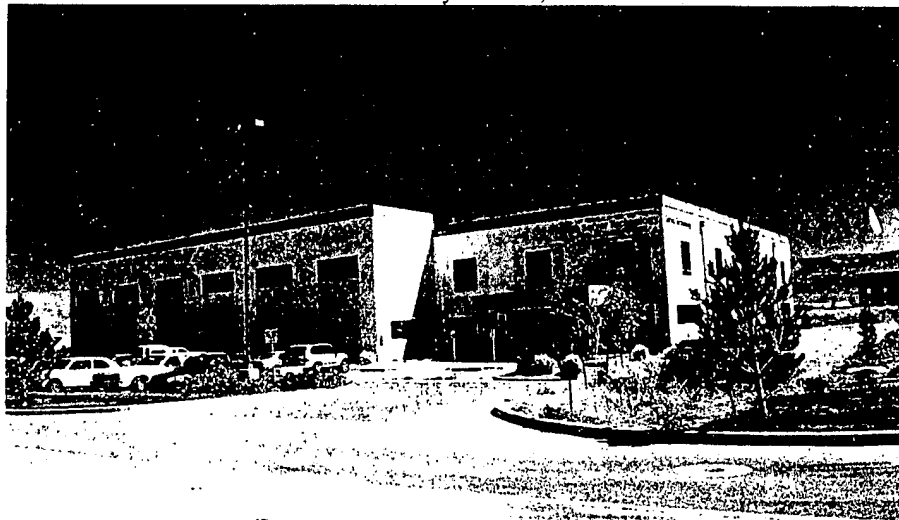
The mission of Server Technology is to design and build effective solutions to meet the needs of its customers through efficient manufacturing processes, attention to detail, focus on quality and devotion to process improvement. Server Technology is the leader in Remote Power Management and is first in its field by "doing the impossible" when responding to customers needs.

Our Customers

Server Technology is dedicated to its customers, providing them with state of the art technology that best suits their needs. Today our customers include leading ISPs, CLECs, RBOCs, banks, airlines, and other large enterprises from corporate America including: Akamai, Bell South, Cisco, Citibank, General Electric, Genuity, Intel, Level 3, Lucent, Microsoft, Microsoft Xbox, Microsoft Zone.com, Motorola, Net2Phone, Siebel Systems, Oracle, Pac Bell, Qwest Communications, Sun Microsystems, Telephia, Touch America, Verio, Williams Communications, Worldcom UUNET

EXHIBIT C

2001 facility in Reno, NV



inside this facility



BEST AVAILABLE COPY

EXHIBIT B

inside previous facility 1997





EXHIBIT D

According to information posted by Bay Technical Associates on its web site as of September 2002:

<http://www.baytech.net/cgi-private/product>

According to information posted on its website in Sept. 2002 by Bay Technical Associates, Inc.,

it was founded in 1976 to develop and manufacture specialized data collection and communications equipment for agencies of the federal government. In the early 1980's, BayTech established the Data Communications Products Division to pursue commercial markets using its technology base. Some of the initial products were print sharers, data multiplexers, and multiport controllers that found their way into a variety of large and small businesses throughout the world. Many of these original products are still in use with continued volume sales for recurring as well as new applications. In support of today's networking environment we have expanded and improved our product line to include remote power controls, data acquisition controllers, and high speed data switches. All of our products are designed to operate in a myriad of environments, from retail stores to industrial floors, from one-person shops to Dow Jones conglomerates.



EXHIBIT E

According to information posted on its website by Western Telematic Inc., in
September, 2002.

<http://www.wti.com/>

it was founded in 1964 and has been an industry leader in designing, manufacturing and marketing of data connectivity solutions. WTI's current product offering includes our NetReach line of remote reboot and remote console management solutions for WAN environments, remote AC power control units and console/AUX port switches, our DataReach line of RS-232 code activated switches and other serial connectivity solutions for the Auto ID and Industrial Automation markets, and our PollCat line of PBX Data (SMDR/CDR) call record buffers.

EXHIBIT F

According to information posted on its website in September 2002 by Pulizzi Engineering Inc.,

it is a leading manufacturer of AC Power Distribution and Control Products. Headquartered in Santa Ana, California, it was founded 27 years ago with a commitment to quality products and services for the OEM industry. It is that continued promise that keeps its clients coming back year after year. The Pulizzi Engineering creed, "Better, Faster, and Less Expensive than you can produce in-house," is something the company takes very seriously. Providing quality, affordable, on-time products is the commitment that delivers success to both the client and Pulizzi Engineering Inc. Since 1958, Mr. Peter S. Pulizzi has been actively involved in the electromechanical packaging industry. Prior to starting Pulizzi Engineering Inc., he was employed by ITT Cannon Electric in Santa Ana, CA, as Manager of Engineering of the Commercial Products Group. Mr. Pulizzi has over 40 years of experience in product engineering, engineering and business management. His memberships include the American Electronic Association, Society of Manufacturing Engineers, International Institute of Connector and Interconnection Technology and American Society for Quality Control. Mr. Peter S. Pulizzi, his wife and three children founded Pulizzi Engineering, Inc. in 1973 as a part-time venture. In the beginning the company was primarily a manufacturing house for MDB systems (now a Lockheed company), specializing in DEC and Data General board level products. In 1977 the part-time effort became full-time and in 1978 Pulizzi Engineering moved from a three-car garage into its first commercial facility. In 1979 they incorporated under the laws of the State of California. 1980 saw an increase in demand for assembly work and wire wrap jobs, which resulted in the purchase of a new 5,400 square foot commercial building. Currently over 21,000 square feet of commercial industrial property is owned and occupied. Scientific Atlanta (Optima Division), convinced Pulizzi Engineering, Inc. to take the company into a new market in 1981 with a 900 piece order for AC power distribution systems. Optima is still a customer of Pulizzi Engineering to this day along with Microsoft, IBM, Qualcomm, Lockheed Martin, Kodak, Motorola, Teradyne, Hughes, BAE Systems, Hewlett Packard, JPL, NASA, and many others. Today, with about 1000 standard, modified standard and custom products and agency approvals consisting of UL, CSA, TUV and CE Mark, Pulizzi Engineering, Inc. has become the largest designer/manufacturer of AC power distribution and control systems world-wide. All departments including engineering, operations and sales/marketing along with manufacturing are fully computerized, incorporating state-of-the-art software. This includes but is not limited to the order entry system, MRP program and sales software. Engineering utilizes the latest version of AutoCAD. Drawings can be mailed, faxed or e-mailed over the Internet for the clients' review and approval prior to manufacturing. On top of that, the entire standard product guide is up on the Internet at www.pulizzi.com. Development of new product technology is on going. In fact, the IPC (Intelligent Power Controller) product line was acknowledged by Electronic Products Magazine as the Editor's Choice of outstanding products. The IPC's allow a user to access via either

RS232 remote access or Ethernet any device to remotely control power from anywhere in the world.

EXHIBIT G

According to information posted by APC on its website in September 2002:

<http://www.apc.com/corporate/>

American Power Conversion (APC) provides protection against some of the leading causes of downtime, data loss and hardware damage: power problems and temperature. As a global leader in power availability solutions, APC sets the standard in its industry for quality, innovation and support. Its comprehensive AC and DC power solutions, which are designed for both home and corporate environments, improve the manageability, availability and performance of sensitive electronic, network, communications and industrial equipment of all sizes.

Its performance has established it among leading businesses worldwide. Accordingly, APC is ranked among the "Fortune 1000" list of the largest U.S. companies, the "Forbes Platinum 400" list of the best big companies in America and is listed on the S&P 500 index.

From corporate headquarters in West Kingston, RI, APC operates sales offices throughout the world and manufacturing facilities on three continents. Together, APC's global teams work to fulfill their mission of creating delighted customers. To do this, the Company focuses its efforts on four primary application areas: Home/Small Office; Business Networks; Data Centers and Facilities; and Access Provider Networks.



EXHIBIT H

According to additional information posted on the APC website in September 2002:

<http://www.apc.com/products/index.cfm>

Management Products [Software]

APC Enterprise Manager

Real-time enterprise level management tool, enabling IT Managers to monitor, configure, and assess their entire APC power infrastructure from a single console.

PowerChute Business Edition

Departmental-level management software, enabling IT administrators to provide safe system shutdown and UPS management for servers and workstations.

PowerChute Personal Edition

PowerChute Personal Edition is easy-to-use, safe system shutdown software with sophisticated power management functions, and is the ideal choice for home APC battery backup users.

PowerChute Network Shutdown

Reliable network based shutdown of multiple computer systems to enhance the manageability of APC UPSs in datacenter environments.

Management Platform Integration

Seamless integration with top management systems to enhance the remote management of multiple APC devices in a network or server management environment.

Application Shutdown Utilities

Easily configurable utilities for network administrators that enables PowerChute to provide safe shutdown of mission-critical applications on servers.

Management Products [Hardware]

Displays

Hand-held control panel for network administrators that configures and controls UPSs in rack, computer room, and datacenter environments.

Building Management Integration

Integrates Silcon to a Building Management System.

Environmental Monitoring

UPS Card or Stand-Alone Unit for network administrators to monitor environmental conditions in a rack, computer room and datacenter environments

Panelmount Environmental Monitoring

Remote monitoring of your panelmount surge protection devices (TVSS) via the web with email event notification.

Interface Cables

UPS serial interface cables that provide direct communication between UPSs and desktops, workstations, and servers.

Interface Expanders

Data Protection for Multiple Servers on one UPS.

Network Management

Network interface cards that provide standards-based remote management of UPSs.

Out-of-Band Management

UPS card for network administrators to manage UPSs remotely via modem throughout the network.

Dry-Contact Management

UPS card for network administrators to control and monitor power through a dry-contact interface in rack, computer room, and datacenter environments.

Remote Power Off

Remote Power-Off device for network administrators that immediately turns off the output of a connected APC UPS in computer room and datacenter environments.

SmartSlot Expansion Chassis

UPS card chassis for network administrators that provides an additional slot in Smart-UPS, Matrix-UPS, Symmetra Power Array, and Silcon UPSs.

Network Hubs

Expand or create a local network without utilizing valuable U-space in a rack-mount environment.

EXHIBIT I
Network

Architecture

and

BELLSOUTH.net



To: Carrel and Brandon Ewing
Server Technology Inc.
Reno, NV. 89511.

CC:

From: Robby Robbins

Date: 6/21/2004

Re: Thanks for your support

Gentleman:

I am writing to express my appreciation to your company for providing such quality products and support. Over the course of the past several years, we have deployed the Sentry 4835-0-4-XL and 4820-0-8-XL across the Bell South.NET network.

Server Tech gives us the ability to remotely manage our DC and AC power feeds in our geographically diverse network. Prior to deployment of these switches, we were suffering protracted and costly outages as a result of dispatches for the simple purpose of cycling power on equipment. Additionally, our equipment used fuse panels, which did not provide as clean a demarcation point as we have today with the pop-out/re-settable circuit breakers.

Our power switches serve a dual function by allowing us to monitor power and temperature with SNMP as well as control power remotely.

The Sentry product line was considered against several competitive options when we chose remote power management and was found to be the best option for us.

Thank you for the superior design and support you continue to provide BellSouth.

Best Regards,

Robby Robbins
BellSouth.net
Network Engineering
Infrastructure Manager